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Atty. Dkt. No. 045054-0145

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Masuyo HORIGUCHI
Title: FOLDABLE PORTABLE CELLULAR PHONE
Appl. No.: 09/920,966
Filing Date: 08/03/2001
Examiner: Knowlin, Thjuan P.
Art Unit: 2642

REPLY TRANSMITTAL

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is an amendment in the above-identified application.

☐ Small Entity status under 37 C.F.R. § 1.9 and § 1.27 has been established by a previous assertion of Small Entity status.

☐ Assertion of Small Entity status is enclosed.

☒ The fee required for additional claims is calculated below:

	Claims As Amended		Previously Paid For		Extra Claims Present		Rate		Additional Claims Fee
Total Claims:	18	-	20	=	0	x	\$50.00	=	\$0.00
Independent Claims:	4	-	4	=	0	x	\$200.00	=	\$0.00
First presentation of any Multiple Dependent Claims:						+	\$360.00	=	\$0.00
CLAIMS FEE TOTAL									\$0.00

☐ Applicant hereby petitions for an extension of time under 37 C.F.R. §1.136(a) for the total number of months checked below:

<input type="checkbox"/>	Extension for response filed within the first month:	\$120.00	\$0.00
<input type="checkbox"/>	Extension for response filed within the second month:	\$450.00	\$0.00
<input type="checkbox"/>	Extension for response filed within the third month:	\$1,020.00	\$0.00
<input type="checkbox"/>	Extension for response filed within the fourth month:	\$1,590.00	\$0.00
<input type="checkbox"/>	Extension for response filed within the fifth month:	\$2,160.00	\$0.00
	EXTENSION FEE TOTAL:		\$0.00
<input type="checkbox"/>	Statutory Disclaimer Fee under 37 C.F.R. 1.20(d):	\$130.00	\$0.00
	CLAIMS, EXTENSION AND DISCLAIMER FEE TOTAL:		\$0.00
<input type="checkbox"/>	Small Entity Fees Apply (subtract ½ of above):		\$0.00
	TOTAL FEE:		\$0.00

- ☐ Please charge Deposit Account No. 19-0741 in the amount of \$0.00. A duplicate copy of this transmittal is enclosed.
- ☐ A check in the amount of \$0.00 is enclosed.
- ☒ The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Please direct all correspondence to the undersigned attorney or agent at the address indicated below.

Respectfully submitted,

Date 12/21/05

By George C. Beck

FOLEY & LARDNER LLP
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George C. Beck
Attorney for Applicant
Registration No. 38,072



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REPLY UNDER 37 CFR 1.111

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This communication is responsive to the Non-Final Office Action dated September 22, 2005, concerning the above-referenced patent application.

Claims 25-42 remain under consideration in this application. The Office Action rejects claims 25-42 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,671,370 to Heinonen et al. in view of U.S. Patent No. 6,560,467 to Kim. Applicant respectfully traverses this rejection and requests reconsideration of the present application in view of the reasons that follow.

The present invention is drawn to a foldable portable cellular phone and method of controlling operation of a cellular phone. The cellular phone recited in all claims includes a key that, upon being actuated causes to be output one of said plurality of sounds which corresponds to a calling party of said received call as stored in said telephone directory memory. Specifically, independent claim 25 is drawn to a cellular phone that includes, among other elements, *“a key operative to provide control signals to said control section to cause said control section to search said call history storing area in said control section and said telephone directory memory and, upon a match resulting from said searching, cause to output one of said plurality of sounds which corresponds to a pre-registered calling party*

*stored in said telephone directory memory.” Independent claim 33 is drawn to “A method of controlling operation of a foldable portable cellular phone having a main body with a speech function, a lid body that is foldable relative to said main body, and a *key operative to provide control signals to a control section in said body*, wherein the method recites, among other things, “*in response to actuation of said key*, searching for said telephone number of a given received call in said telephone directory memory and in said call history storing unit and, upon a match resulting from said searching, outputting one of said plurality of sounds which corresponds to a calling party of said received call as stored in said telephone directory memory.” Independent claim 34 is drawn to a portable phone that includes, among other elements, “*a key configured to be operated by a user*,” and “*a controller, coupled to the memory and the key*, said controller being configured to store information in memory about a calling party whose call has been received and to cause generation of a sound, that is stored in association with the calling party, *in response to the key being operated by the user*. Independent claim 39 is drawn to a portable phone that includes “*a key configured to be operated by a user*,” and “*a controller configured to store information in memory about a calling party whose call has been received and to drive the vibrator to cause a vibration corresponding to the calling party in response to the key being operated by the user*.”*

The above noted features demonstrate that all claims recite a cellular phone operated by a called party who receives a call and causes generation of a sound or vibration at the called party’s cellular telephone in response to the key on the called party’s phone being actuated by the called party. In contrast, the reference principally relied upon in the Office Action, Heinonen, fails to teach, describe or suggest a cellular phone with a key operated by a called party as recited in the claims.

The Office Action alleges that Heinonen discloses such a key at column 7, lines 19-35. Applicant respectfully disagrees.

Heinonen is drawn to a telephone system that enables a calling user to predetermine the ringing indication that will be played or sounded and/or shown or displayed at the location of the receiving user. *E.g.* col. 2, lines 11-16. More particularly, Heinonen describes a LAN that includes telephone handsets. According to Heinonen, a user at handset 23 places a call to a user at handset 24. *See* col. 7, lines 14-15. Heinonen further states that “when the user at handset 23 [i.e., the calling party] desires to provide a ringing information that specifies a ringing indication to the user at handset 24, the user at handset 23 [again the calling party]

first selects a ringing indication(s) from the data file 22; i.e., the caller user uses his/her telephone set to select the relevant option(s) from data file 22.” See col. 7, lines 19-24.

The portion of the disclosure cited by the Examiner states that “handset 23 may be provided with a special access key, or the user at handset 23 may access data file 22 by entering a special 4-digit code by way of key pad 26.” Col. 7, lines 28-31. Consequently, Heinonen indicates that the keypad or special access key is provided at the handset of the calling party 23, *not* the called party 24. Further, the keypad or special access key is *not* actuated at the called party’s handset to cause generation of a sound or vibration that is stored in association with the calling party, as recited in the present claims.

The secondary reference cited in the Office Action does not suggest or teach the features lacking from Heinonen. Consequently, the pending claims are patentable over the cited references.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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